



PATENT
Customer No. 22,852
Attorney Docket No. 02100.0071-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
James B. POPP et al.)	Group Art Unit: 2612
)	
Application No.: 09/837,228)	Examiner: Benjamin C. Lee
)	
Filed: April 19, 2001)	Confirmation No.: 7579
)	
For: FIRE SUPPRESSION AND)	
INDICATOR SYSTEM AND FIRE)	
DETECTION DEVICE)	

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 1.193, Appellants submit this Reply Brief under 37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), in response to the November 15, 2006 Examiner's Answer in this case.

I. Grounds of Rejection - Claim Status

In the Examiner's Answer dated November 15, 2006 ("Examiner's Answer") at page 4, at sub-section "Claim Status," the Examiner alleges that "[c]laim 52 is a redundancy of claim 18." Appellants respectfully submit that the Examiner's "redundancy" allegation is erroneous. In particular, Appellants' independent claim 18

recites subject matter that is not recited in independent claim 52. Independent claim 18 recites at lines 5-6, “the storage units comprising at least one of a container and a pallet” Appeal Brief at 32. Independent claim 52 does not recite such subject matter. See id. at 37-38. Therefore, Appellants respectfully submit that independent claims 18 and 52 are not redundant, as alleged by the Examiner.

II. Response to Argument

In a section entitled “(10) Response to Argument” (“Response to Argument”) at pages 14-17 of the Examiner’s Answer, the Examiner makes a number of erroneous allegations concerning the subject matter purportedly disclosed and/or rendered obvious based on the Granek and Powell references. The Examiner apparently concedes that Granek does not disclose a system for detecting and suppressing a fire in a storage unit for storing freight in a storage area containing a plurality of storage units. In particular, the Examiner acknowledges that Granek discloses “a fire detection and extinguishing system applied to a premise/facility having a plurality of compartments” Examiner’s Answer at 14. The Examiner alleges, however, that Granek’s disclosure relating to a fire protection apparatus for installation in a building is “merely an intended use of the Granek et al. system.” Id. at 15. The Examiner further alleges that it would have been obvious for someone in Granek’s field of art relating to fire protection in buildings to have sought out a new intended use for Granek’s teachings, and further, that someone in Granek’s field of art relating to fire protection in buildings would have looked to Powell’s field of systems for extinguishing and

controlling fires in an aircraft cargo area to determine the new intended use. See id. at 15-16.

Appellants respectfully submit that the Examiner's obviousness analysis is improper under the prevailing law of obviousness. The Examiner's obviousness rationale appears to be that if the prior art discloses a system having a particular intended use, then it would have been obvious to (1) seek another intended use for the system and (2) look to the prior art of an intended use relating to an application's claims to find the other intended use.

Appellants respectfully submit that such a self-fulfilling analysis is merely a form of improper hindsight reasoning, contrary to current U.S. law of obviousness. Under prevailing U.S. obviousness law, the correct analysis is to

- (1) Determine the scope and contents of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

M.P.E.P. § 2141 (citing Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966)). Moreover, according to the guidance of the U.S. Court of Appeals for the Federal Circuit ("the Federal Circuit"), in order to prevent the improper rejection of a claim based on statutorily proscribed hindsight reasoning, there must be some suggestion or motivation in the prior art to modify a reference or to combine reference teachings. See, e.g., Alza Corp. v. Mylan Labs, Inc., 464 F.3d 1286, 1289-91, 80 U.S.P.Q.2d (BNA) 1001, 1003-04 (Fed. Cir. 2006) (explaining the requirements for establishing obviousness). In particular, "[t]he teaching or suggestion to make the

claimed combination . . . must . . . be found in the prior art, not in applicant's disclosure."

M.P.E.P. § 2143 (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Furthermore, according to the Federal Circuit's guidance, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)) (emphasis in original).

Appellants respectfully submit that the Examiner's obviousness allegations improperly rely on hindsight reasoning and Appellants' disclosure. There is no disclosure in Granek that suggests seeking an alternative, alleged intended use for Granek's teachings. Further, there is no disclosure in Granek that suggests looking to Powell's art relating to cargo aircraft for seeking an alternative, alleged intended use for Granek's teachings. Rather, Appellants' disclosure and hindsight reasoning are the only sources for supplying the Examiner's alleged intended use of detecting and suppressing a fire in a storage unit for storing freight in a storage area containing a plurality of storage units. Since it is improper to rely on Appellants' disclosure and hindsight reasoning as purported support for an obviousness rejection under 35 U.S.C. § 103(a), Appellants respectfully submit that the Examiner's claim rejection under 35 U.S.C. § 103(a) based on the Examiner's proposed, hypothetical combination of Granek and Powell is improper and should be reversed.

In the Examiner's Answer, the Examiner alleges that Appellants are "apparently . . . analyzing the prior art references individually and alleging that none of the prior art alone, instead of in combination, suggests or meets the particular claimed limitations."

Examiner's Answer at 17. The Examiner is apparently referring to the portion of Appellants' Appeal Brief, which responds to the Examiner's allegation that Ronald discloses that "use of infrared signals as opposed to radio signals in an aircraft environment to reduce interference is well known in the art and therefore its use is obvious in Granek et al. when used in an aircraft environment vulnerable to signal interference." Final Office Action at 4. Appellants pointed out in the Appeal Brief that one of ordinary skill in the art considering Granek would have had no motivation to use infrared signals to reduce interference in an aircraft environment, since Granek relates to buildings rather than aircraft. Appeal Brief at 22.

In the Examiner's Answer, the Examiner alleges that a combined system of Granek et al. and Powell et al. "establishes applying the fire detection and extinguishing features in the 'aircraft environment', whereby one skilled in the art would have readily recognized that radio signals constitute a source of interference in an aircraft environment where sensitive communication and electronic equipment are operating" Examiner's Answer at 16-17. Appellants' respectfully submit that for at least the reasons outlined in the Appeal Brief and previously herein, the Examiner's combination of the teachings of Granek and Powell is improper. Therefore, the Examiner's reliance on the "combined system of Granek et al. and Powell et al." in order to create a fictitious reference relating to an "aircraft environment" is improper. Since Granek's disclosure is not concerned with "interference" of "sensitive communication and electronic equipment" or an "aircraft environment," it would not have been obvious for a person having ordinary skill in Granek's art of fire protection in buildings to substitute radio signals for infrared signals, as alleged by the Examiner.

III. **Conclusion**


For the reasons presented in the Appeal Brief filed October 2, 2006, as well as the reasons outlined above, the Board is kindly requested to reverse all of the outstanding claim rejections, so that pending claims 1-26 and 41-61 may be allowed.

To the extent that any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 16, 2007

By: 
Christopher T. Kent
Reg. No. 48,216